

REMARKS

The specification has been amended to provide consistent reference numbers when directing to the same part.

Claims 80 to 94 remain pending in the application. Of these, claims 80, 85, 87 and 90 are currently amended. Claims 80, 87, and 90 are the independent claims.

Reconsideration in view of the foregoing amendments and remarks and allowance of claims 80 to 94 is respectfully requested.

Claim 85 is objected to because of lack of a period. A period has been placed at the end of Claim 85.

The Examiner indicates that the Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date. Applicant's Renewed Petition for an Unintentionally Delayed Benefit Claim Pursuant to 37 C.F.R. 1.78(a)(3) has been granted (Attachment A).

Claims 80 to 94 are rejected under the doctrine of obviousness-type double patenting over claims 1 to 11 of commonly owned U.S. Patent No. 6,607,544 (the '544 Patent). Applicant will submit a terminal disclaimer based on the '544 Patent upon the indication of allowable subject matter, but for the double patenting rejection.

Claims 80-94 are rejected in various combinations under 35 U.S.C. §102(b) as anticipated by Reiley et al. WO 95/20362 (Reiley WO 95/20362) or under 35 U.S.C. §103(a) over Reiley WO 95/20362 in view of Reiley et al. WO 98/56301 (Reiley WO 98/56301). Applicant's claim of priority as proposed in the Renewed Petition as based upon application Serial No. 08/788,786, filed January 23, 1997, and application Serial No. 08/188,224, filed January 26, 1994, removes Reiley WO 95/20362 and Reiley WO 98/56301 as prior art references to the instant application. Therefore, Applicant respectfully requests that these rejections be withdrawn.

Claims 80, 87, and 90 have been amended to indicate that the diameter and wall thickness relationships defined in the claims exist when the device is in its normal expanded shape and at its operating inflation volume. The terminology of these claims used to define the capability of the expandable structure to expand beyond a preformed, normally expanded shape to a reach an inflation volume, parallels the terminology used in issued claim 1 of the parent '544 Patent. Applicants believe that the Examiner's rejection of claims based upon Tower et al. U.S. 5,352,199 (which is also of record as having been considered in the '544 Patent) have been overcome.

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Amendment C

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Claims 80 to 94 are believed to be in condition for allowance, but for the pending double patenting rejection. To expedite prosecution, Applicants offer to cooperate, following notice by telephone that allowable subject matter exists absent double patenting, by promptly submitting by fax a terminal disclaimer based on the '544 Patent, which would bring prosecution to an end without need for an additional Office Action.

Respectfully Submitted,

By 

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26 October 2004

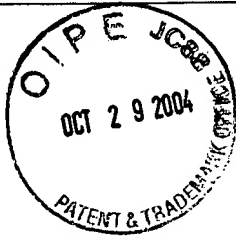
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KYPHON/1759/15103-002/041026 AMENDMENT C

Enclosures: Amendment Transmittal Letter
Attachment A
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OFFICE OF PETITIONS

In re Application of
Robert M. Scribner et al
Application No. 09/837,350
Filed: April 18, 2001
Attorney Docket No. 1759.15103-CON

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed May 3, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on April 18, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

Attachment A

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The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Irvin Dingle at (703) 306-5684.

This application is being forwarded to Technology Center Art Unit 3743 for appropriate action on the amendment filed May 3, 2004, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications.



Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Corrected Filing Receipt